

3600.1622-D1
January 17, 2003 (12:52pm)

Docket: AM-1622.D1

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(m)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Flong SHIH et al.

Attorneys Docket: AM-1622.D1

Serial No.: 09/489,356

Art Unit No.: 1763

Filed: January 21, 2000

Examiner: R. Zervigon

For: "COATING BORON CARBIDE ON ALUMINUM"

Commissioner of Patents and Trademarks
ATTN: Director, Technology Center 1700
Washington, DC 20231

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Sir:

The Commissioner is petitioned under 37 CFR §§1.113(a) and 1.181 and MPEP §1002.02(c) to reverse the implicit decision of the Examiner dated January 6, 2003 to not withdraw the finality of the rejection dated November 5, 2002 and is further petitioned under 37 CFR §1.127 to enter the amendments presented in the response of December 18, 2002.

The non-final Office Action of April 25, 2002 rejected all the claims including base Claims 1 and 13 over the combination of Linke, Kramer, and Ponnekanti. The response of July 11, 2002 did not amend Claims 1 and 13 although other claims were amended. The Office Action of November 5, 2002 rejected Claims 1 and 13, among other claims, over the combination of Quartarone and Linke, and did not repeat the prior rejection. The response of December 18, 2002 requested that the finality of the rejection be withdrawn and then amended several of the claims. The Advisory Action dated January 6, 2003 did not directly address the request for withdrawal of the finality but did not withdraw it. The Advisory further refused to enter the amendments because they raised new issues.

According to MPEP §706.07(a), a final rejection is not proper when "the examiner

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introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in [a late filed with fee] information disclosure statement ... ". There was no late filed information disclosure statement prior to the final rejection. Because Applicants did not amend Claims 1 and 13 in the response dated July 11, 2002, the subsequent final rejection dated November 5, 2002 of Claims 1 and 13 could not be "necessitated by applicant's amendment of the claims" MPEP §706.07(a) and is therefore improper. Accordingly, the Commissioner is requested to withdraw the finality of rejection and to allow continued prosecution over the new art applied in the Office Action of November 5, 2002.

Further, since the finality of the rejection is improper, the Commissioner is further petitioned under 37 CFR §1.127 to instruct the Examiner to enter the amendments presented in the response of December 18, 2002.

It is not clear that a fee is required for this petition. However, if a fee is required, the Commissioner is authorized to charge the required fee to Deposit Account 50-0636. A duplicate of this letter is submitted.

If the Director or the Examiner believes that a telephone interview would be helpful, he is invited to contact the undersigned attorney at the listed telephone number, which is on California time.

Respectfully submitted,

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